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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,317	01/14/2004	Mary Jo Winterer	AP35651 - 070457.1675	3521
21003 7590 08/14/2009 BAKER BOTTS L.L.P. 30 ROCKEFELLER PLAZA 44TH FLOOR NEW YORK, NY 10112-4498				
EXAMINER				
LIU, CHIA-YI				
ART UNIT		PAPER NUMBER		
3696				
NOTIFICATION DATE		DELIVERY MODE		
08/14/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/757,317

Applicant(s)

WINTERER ET AL.

Examiner

CHIA-YI LIU

Art Unit

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-5, 7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5 and 7-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to an amendment submitted 05/05/2009. Upon careful consideration of applicant's amendments and arguments, new grounds of rejections for Claims 1, 3-5, and 7-8, necessitated by applicant's amendments, are established as set forth in detail below.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 5, 7 and 8 are rejected under 35 USC § 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent and recent Federal Circuit decisions, a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter. To qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. (See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). There is insufficient tie in the claims to a specific machine or structure.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "Charges accumulated using said credit payment card are deducted automatically from said depository account corresponding to a user-determined deduction cycle and applied to said credit card balance," is a new matter which was not described in the specification. More specifically, applicant's specification only teaches "charges are automatically deducted on a periodic basis as agreed upon by the cardholder and issuing financial institution," (see paragraph 0004) and does not require the deduction cycle be determined by a user. Removal of the new matter is required.

Claims 1, 3-5, and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buccì (US 6,786,400) in view of Bailo (US 2004/0122769 A1), further in view of Official Notice, and further in view of DeSane (US 2003/0014018 A1).

As per Claims 1, 5

Buccì ('400) discloses,

a consumer depository account (checking account) maintained by a first (second) financial institution holding funds on behalf of said consumer, see Fig 3 (345, 350) and column 2, lines 6-9.

a credit payment card for conducting two or more transactions and incurring charges associated with each such transaction, see column 2, lines 2-9 (conduct at least one transaction/conduct at least one other transaction = two or more transactions) and column 7, lines 45-56 (the card can be a credit card)

said card being issued to said consumer by a second financial institution, see column 7, lines 45-56 (The card can be a credit card. Regardless of the type of card...the card number is operable to access both credit account and an account being funded with money. The accounts may be with the same financial institution or separate financial institution).

Buccì ('400) teaches said card further being linked to said depository account (checking account) maintained at said first institution, see column 2, lines 6-14 and column 7, lines 45-56, but fails to explicitly disclose the depository account is used for covering said charges associated with the transaction conducted by the credit payment card. Bailo ('769) teaches depository account is used for

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covering said charges associated with the transaction conducted by a credit payment card, see at least paragraph 0027 (an account holder has a checking account via a bank and a credit card account via a credit card issuer... use the checking account to make payment towards the credit accounts balance). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bucci's invention to include the depository account is used for covering said charges associated with the transaction conducted by the credit payment card. One would be motivated to do so for the benefit of saving time and preventing late payment.

Bucci ('400) teaches a credit payment card, see column 7, lines 49-51, and a credit line balance, see column 5, line 49-51, but fails to explicitly disclose a payment cycle is associated with said credit payment card and a credit payment card balance reflects a spending limit associated with said credit payment card. Official Notice is taken that it is old and well known to have a payment cycle associated with a credit card and a credit card balance reflecting a spending limit associated with the credit card (For example, Bank of America, Wells Fargo, and most other major banks allows user to associate credit card with a payment cycle and provide customers with credit card balance reflecting his/her spending limit on the card.) Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bucci's invention to include a payment cycle is associated with said credit payment card and a credit payment card balance reflects a spending limit associated with said credit payment card. One of ordinary in the skill would be motivated to do so, for the benefit of allowing customers to keep track of the balance and avoiding over-spending.

Bucci ('400) does not specifically disclose at least a portion of said charges accumulated using said credit payment card are deducted automatically from said depository account on a periodic cycle corresponding to a user-determined deduction cycle and applied to said credit card balance. DeSane ('048) teaches at least a portion of said charges accumulated using said credit payment card are deducted automatically from said depository account on a periodic cycle, see paragraph 0027 (monthly credit card bills to be paid by direct withdrawal from the debtor's checking account). Official Notice is taken that it was old and well known in the art to have deduction/payment cycle determined by a user and to apply charges to credit card balance. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bucci's invention to include at least a portion of said charges accumulated using said credit payment card are deducted automatically from said depository account on a periodic cycle corresponding to a user-determined deduction cycle and applied to said credit card balance. One

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of the ordinary skill in the art would be motivated to do so, for the benefit of saving time and preventing late payment.

(Regarding Claim 1, further it has been held while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429,1431-32 (Fed. Cir. 1997).)

As per Claims 3, 7

Bucci ('400) further discloses a credit limit is associated with said card, see column 11, lines 4-5 and column 6, line 40 (credit limit associated with the credit account) but fails to explicitly disclose the credit limit is reduced based on said charges, and refreshed automatically as a function of said deducting means, Official Notice is taken that it was old and well known in the art to reduce credit limit base on charges and refresh credit limit automatically as a function of deducting means. Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Bucci's invention to include which limit is reduced based on said charges, and refreshed automatically as a function of said deducting means. One of ordinary skill in the art would be motivated to do so for the benefit of keeping updated record of how much the cardholder can spend using the credit card.

As per Claims 4, 8

Bucci ('400) does not specifically disclose billing means operated by said second financial institution for periodically informing said consumer of said charges made on the card and of the amount received from said consumer depository account to cover said charges. Official Notice is taken that it was old and well known in the art to for a credit card company to inform consumer periodically of the charges made on his/her credit card and of the amount received to cover the charges. (For Example, monthly credit card statements) Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bucci's invention to include billing means operated by said second financial institution for periodically informing said consumer of said charges made on the card and of the amount received from said consumer depository account to cover said charges. One of ordinary in the skill would be motivated to do so, for the benefit of allowing customers to keep track of the balance and avoiding over-spending.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Cataline (US 2003/0055783 A1): schedule fund transfer from checking/deposit account to credit card account wherein the accounts can be externally associated with each other, see at least paragraph 0030-0033 and 0100-0102. Rothman (US 2003/0208438 A1): monies from deposit account are committed to cover debt in credit account wherein the deposit account can be the same bank or other institution, see at least paragraphs 0067-0068.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHIA-YI LIU whose telephone number is (571)270-1573. The examiner can normally be reached on Mon-Thur alternating Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TOM DIXON can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frantzy Poinvil/
Primary Examiner, Art Unit 3696

CHIA-YI LIU
Examiner
Art Unit 3696